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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,960	06/04/2001	Kazuhiro Kudoh	00-169925	2545

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EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,960

Applicant(s)

KUDOH, KAZUHIRO

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☒ Claim(s) 2-3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. **Claim 2** recites the limitation "the external instruction" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 is objected for the same problem.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 13-18, 21-26 and 29** are rejected under 35 U.S.C. 102(b) as being anticipated by Brennan (US 5,903,628).

Regarding **claim 13**, Brennan discloses a communications terminal (column 4, lines 17-21) comprising:

a memory storing a character string for a calling party, the character string to be retrieved from the memory upon a receipt of a call from the calling party for outputting voice information (column 3, lines 3-31) [The data memory 42 stores the ASCII characters of the callers names to be displayed and also be sent to the speech

synthesizer 80 to outputs the name announcements to the hands-free speaker upon receiving an incoming call from that caller].

Regarding **claim 14**, Brennan discloses a speaker (26 on FIG. 1); and a controller that controls the speaker to output the voice information in response to a call from the calling party based upon the character string that was stored before the call from the party (column 3, lines 3-31).

Regarding **claim 15**, Brennan discloses a converter that converts the character string into an analog voice waveform (column 3, lines 3-31).

Regarding **claim 16**, Brennan discloses a switch to control a retrieval of the character string and a conversion of the character string into an analog waveform (column 3, lines 3-31).

Regarding **claim 17**, Brennan discloses a speaker in communication with the memory (column 3, lines 3-31).

Regarding **claim 18**, Brennan discloses the controller determines whether the call is from the party based upon caller identification data (column 3, lines 3-31).

Regarding **claim 21**, Brennan discloses the character string comprises a digitized voice signal (column 3, lines 3-31).

Regarding **claim 22**, Brennan discloses the memory comprises a telephone directory that stores the character string (column 2, lines 45-59).

Regarding **claim 23**, Brennan discloses the communications terminal comprises a mobile communications terminal (column 4, lines 17-21).

Regarding **claim 24**, Brennan discloses a method for identifying a caller in a mobile terminal (column 4, lines 17-21), comprising:

determining whether a memory includes a character string that corresponds to a caller(column 3, lines 3-31) [The main controller 34 reads the matching name of the caller in a series of ASCII characters]; and

outputting a voice signal that corresponds to the character string if the character string corresponds to the caller (column 3, lines 3-31) [The main controller forwards the read name to the speech synthesizer 80 which translates the read name into a voice announcement and outputted to the hands-free speaker].

Regarding **claim 25**, Brennan discloses receiving caller identification data and wherein the determining comprises determining whether the character string

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corresponds to the caller based upon the caller identification data (column 3, lines 3-31).

Regarding **claim 26**, Brennan discloses storing the character string in a telephone directory before the determining (column 2, lines 45-59).

Regarding **claim 29**, Brennan discloses the voice signal is only output in response to an input by a user (column 3, lines 3-31).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-12, 19-20, 27-28 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan in view of Muramatsu (US 2001/0051536).

Regarding **claims 1, 6, 9 and 10**, Brennan discloses a mobile communications terminal device (column 4, lines 17-21), comprising:

storage means (Data Memory 42 on FIG. 1) for registering beforehand a name of an originator, one of the telephone number and a mail address of the originator, a kind of an incoming identification tone at a time of a call incoming from the originator and a character string corresponding to a voice information designating the originator (column 4, lines 31-47) [The user enters the telephone number names and path-type indication and also records the voice utterances are recorded into the data memory 42 for voice announcements];

control means (Main Controller 134 on FIG. 1) for controlling the voice output means to output the voice information corresponding to the character string registered beforehand in the storage means in response to an instruction while the voice output means is ringing (column 4, lines 48-65) [The main controller 134 in response to an incoming call matching the number and names and reads the voice announcement recorded previously to announce the caller over the speaker 26 to the called party].

Brennan discloses the user entering a plurality of telephone numbers and associated names and addressees into the memory prior receiving an incoming call (column 2, lines 45-59).

Brennan further discloses a ring detector to detect ringing signal from the incoming call (column 3, lines 3-31), and also discloses the system can be an analog telephone, a digital telephone or a wireless telephone (column 4, lines 17-21).

Note, recording an incoming identification tone to identify a caller is well known.

For example, Muramatsu teaches a voice output means for ringing with the kind of the incoming identification tone corresponding to the originator at the time of the call

incoming (§ 0033, § 0061) [The memory RAM 6 stores the name data of the caller and sound patterns associated with the caller names. The controller 12 outputs the sound pattern to the notification section 11 at the time the name is found and the sound pattern corresponding to that name].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Brennan using the sounds patterns memory as taught by Muramatsu.

This modification of the invention would offer the capability of recording a sound pattern such as the system would allow the user to recognize whom is calling before the phone goes off-hook.

Regarding **claims 2 and 7**, Brennan discloses the control means controls the voice output means to output the voice information after stopping the ringing in response to the external instruction (column 3, lines 3-31).

Regarding **claims 3 and 8**, Brennan discloses the control means controls the voice output means to output the voice information after reducing an output volume of ringing in response to the external instruction (column 4, lines 48-65).

Regarding **claim 4**, Muramatsu teaches the voice output means outputs the voice information corresponding to one of the telephone number and the mail address

of the originator as the incoming identification tone at the time of the call incoming (§ 0033).

Regarding **claim 5**, Brennan discloses the voice output means outputs the primary information regarding one of the discriminating ringing and the originator as the voice information instead of the incoming identification tone (column 3, lines 3-31).

Regarding **claim 11**, Brennan discloses the instruction comprises an input from a switch mounted on an exterior of the mobile communication terminal device (column 3, lines 3-31).

Regarding **claim 12**, Brennan discloses the outputting of the voice information is in response to an external instruction during the ringing (column 4, lines 48-65).

Regarding **claim 19**, Muramatsu teaches the memory further stores a tone for the party (§ 0033).

Regarding **claim 20**, Muramatsu teaches the controller controls the speaker to output the tone in response to a call from the party (§ 0061).

Regarding **claim 27**, Muramatsu teaches storing a tone in the telephone directory (§ 0033);

determining whether the tone corresponds to the caller (§ 0033); and
outputting the tone if the tone corresponds to the caller before outputting the
voice signal (§ 0061).

Regarding **claim 28**, Muramatsu teaches initially running an identification tone in
response to a call from the caller (§ 0061).

Regarding **claim 30**, Muramatsu teaches a user selectively prompts the output of
the voice signal while an identification tone, corresponding to the caller, is ringing (§
0061).

Response to Arguments

6. Applicant's arguments with respect to **claims 1-30** have been considered but are
moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in
this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER
g.g.

August 2, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over the printed name and title.